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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,627	05/24/2001	Nobuaki Hashimoto	109609	3172

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[REDACTED] EXAMINER

SOWARD, IDA M

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2822

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/856,627	HASHIMOTO
	Examiner	Art Unit
	Ida M Soward	2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 June 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

This Office Action is in response to the Applicant's amendment filed on June 27, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salatino (5,117,282).

Salatino teaches an interconnect substrate **61** over which an interconnect pattern is formed, comprising: a first portion **21-**; and a second portion **22-** to be superposed on the first portion, wherein the first portion has end parts as positioning references; wherein the second portion has a shape so as to be superposed on and inside the first portion except the end part **25**, the second portion positioned between the end parts; each of the end parts as the positioning references includes two edges that are perpendicular to each other; the first portion comprises a rectangular body section and a projected section **111** which extends from at least one edge of the body section and includes one of the end parts (Figures 1-5); the projected section is a region determined by: an edge which is a boundary between the projected section and the body section; a

first edge which is perpendicular to the edge as a boundary; and a second top edge which is parallel to the edge as a boundary, wherein one of the end parts as the positioning reference includes the first and second edges; the body section **27** of the first portion includes an edge having no projected section; and wherein the second portion is disposed adjacent to the edge having no projected section; the second portion has a depressed section **24** facing the projected section of the first portion; at least one of the end parts is formed from an area in the body section other than an area from which the projected section extends; the first portion (which includes the middle section of Figure 1) is larger than the second portion, and the two edges which are perpendicular to each other form a corner section of the first portion; the first portion has a depressed end part (area **23**) including the two edges which are perpendicular to each other and have a right angle; a plurality of holes **18 & 19** formed in end parts; the second portion continuously extends from the first portion; the second portion is separated from the first portion (Figure 1); and wherein the first and second portions are connected by the interconnect pattern (Figure 4); a semiconductor device comprising: at least one semiconductor chip **69**; and a substrate **61** which has a first portion and a second portion to be superposed on the first portion, and on which the semiconductor chip is mounted, wherein the first portion includes end parts as positioning references; and wherein the second portion has a shape so as to be superposed inside the first portion and avoid being superposed over the end parts of the first portion, the second portion positioned between the end parts; and a plurality of external terminals **83** are provided in the first portion. In regard to the functional language "as a position"

reference", claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). In regard to claims 18-20, note that a "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Fitzgerald*, 205 USPQ 594, 596 (CCPA); *In re Marosi et al.*, 218 USPQ 289 (CAFC); and most recently, *In re Thorpe et al.*, 227 USPQ 96 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or no. Note that Applicant has burden of proof in such cases as the above case law makes clear. As to the grounds of rejection under section 103, see MPEP 2113. However, Salatino fails to teach an electronic instrument provided with the semiconductor device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an electronic instrument with the semiconductor structure of Salatino in order to utilize the integrated circuit devices (cols. 1-2, lines 6-68 and 1-10, respectively).

R sponse to Arguments

Applicant's remarks filed February 19, 2003 have been fully considered but they are not persuasive. Salatino does teach a second portion **22-** superposed inside the first portion **21-** when the interconnect substrate is folded only at one boundary of the first and second portion (Figures 2-4). Salatino further teaches end part **25** and the end part connected to **22-1** in Figure 1.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ida M Soward whose telephone number is 703-305-

3308. The examiner can normally be reached on Monday - Thursday, 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 703-308-4905. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

ims
August 28, 2003



AMIR ZARABIAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800